

REMARKS

The informalities noted by the Examiner in claims 47, 49, 51, 56, 58, and 60 have been corrected.

In response to the objections to the drawings, Applicants have amended Fig. 3 to explicitly show the features mentioned in the Office Action. Support for this amendment can be found in the specification at Pg. 16, lines 10-20 (for muting), lines 3-6 (for the handset being removed), and lines 1-3 (for the hookswitch being released), for example. Further support can be found in the specification at Pg. 19, lines 6-14 (for unmuting) and Pg. 18, lines 15-21 (for the handset being replaced and the hookswitch being depressed), for example.

Claims 46-49, 52, 53, 55-58, 61, and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,497,980 to Gorman et al. ("Gorman") in view of U.S. Pat. No. 2,561,950 to Shenk ("Shenk"). Applicants respectfully traverse the rejection.

Gorman discloses a voice controlled handsfree switching circuit for a telephone instrument. The voice switching circuit is downstream of the speech network of the instrument (Col. 1, lines 47-57; Col. 2, lines 5-8; Fig. 1). The circuit has a normal handset mode, along with a call announcer and a handsfree capability using a common loudspeaker (Col. 1, lines 61-64). Placing a call in handsfree mode disables the handset and bypasses hookswitch access to the speech network (Col. 2, lines 8-11; Fig. 1; Fig. 4A). The handsfree mode for the present instrument is enabled in response to depression of a switch at the telephone instrument and is effective regardless of the condition of the handset—on hook or off hook (Col. 2, lines 59-63; Fig. 1; Fig. 4A).

Closure of the HF ON button initiates the handsfree operation by setting the handsfree switch S31 and activating the handsfree switching network, completing the handsfree circuit paths and inactivating the handset path (Col. 7, lines 44-49; Fig. 3). Particularly, the handsfree switch directs the circuit to place a ground on the RELAY lead to operate RLY1 to switch the speech network to

handsfree operation and inactivate the handset receiver and transmitter (Col. 4, lines 35-39; Fig. 2; Fig. 3). The relay is energized and closes contacts K1-K8 (Col. 7, lines 1-6; Figs. 4A, 4B, 4C). From the foregoing it can be seen that the position of the hookswitch—on hook or off hook—is of no consequence to the handsfree mode of operation (Col. 7, lines 42-44). Gorman also discloses a manual microphone switch which is closed manually to provide privacy by muting the handsfree microphone (Col. 4, lines 50-54; Fig. 3). However, during the handsfree mode of operation, Gorman does not disclose or suggest any action related to handset positioning, much less muting the handsfree microphone.

Shenk discloses an automatic telephone dial light attachment. The attachment includes a trip member that is actuated by the weight of a handset receiver, such that when the receiver is picked up for dialing, a light comes on automatically (Col. 1, lines 23-30). However, Shenk does not disclose or suggest any action relating to audio inputs or outputs, nor does Shenk disclose or suggest switching in the context of a handsfree mode of operation.

Conversely, claim 46 recites, "in response to the handset being removed from the handset-receiving portion during the telephone call, muting the audio input and maintaining to communicate the audio output of the telephone call via the hands-free audio interface." Neither Gorman nor Shenk, alone or in combination, disclose or suggest this claim element.

First, as cited above in at least three different locations in the written specification and at multiple locations in the drawings, Gorman teaches against any sort of handset activation during the handsfree mode of operation (Col. 2, lines 8-11; Col. 2, lines 59-63; Col. 4, lines 32-39; Col. 7, lines 42-49; Fig. 1, HK SW; Fig. 2, RLY1; Fig. 3, S31; Fig. 4A, HKSW). This teaching against activation of the handset is not limited to a particular embodiment and is present throughout the Gorman invention. In fact, even in the use of four wire call announcing, the handset is also specifically taught as inactive (Col. 2, lines 64-68). Thus, the Gorman reference teaches against combination with Shenk or any other

reference to provide handset activation during handsfree operation. Therefore, for at least these reasons, Applicants respectfully request that the rejection to claim 46 be withdrawn.

Further, Gorman states the advantage of locating the voice switching circuit downstream of the speech network (Col. 1, lines 47-57; Col. 2, lines 5-8). The HK SW switch, corresponding to the handset hook switch, is **upstream** of the speech network, and MIC, the manual microphone switch, and its associated switches, are located **in and downstream** of the voice switching circuit (Fig. 1; Fig. 3, 4C). Relocating the MIC switch and/or the HK SW switch is not only not disclosed or suggested by Gorman or Shenk, alone or in combination, but such relocation is explicitly against the teaching of Gorman. Therefore, for at least these reasons, Applicants respectfully request that the rejection to claim 46 be withdrawn.

The Office Action states that combining the handset switch of Shenk and the manual microphone switch of Gorman would be obvious for the purpose of reducing the number of switches required on the manual inputs portion of the apparatus. However, turning the Gorman handset into a microphone switch would greatly increase the amount and complexity of circuitry over the current Gorman implementation, militating against such a combination. Moreover, the components and design of this circuitry to provide handset-based actuation of the manual microphone switch are not disclosed or suggested by Gorman or Shenk, alone or in combination. Particularly, they do not disclose or suggest the new circuitry and switches required to 1) activate the hookswitch during handsfree mode or 2) provide the hookswitch the functionality of a manual microphone switch. Therefore, for at least these reasons, Applicants respectfully request that the rejection to claim 46 be withdrawn.

Finally, the manual microphone switch of Gorman is used to provide privacy (Col. 4, line 52). The step of removing a handset instead of pressing a button would not forward the stated purpose of the Gorman manual microphone

switch—privacy. Instead of quickly pressing a button to achieve privacy, one would be forced to lift the handset from its receiving portion and find a place to put it on one's desk or in some other location. In such a case, as a practical matter, the manual microphone switch would be an **improvement** over the use of a handset-activated microphone switch. Thus, there is no suggestion to combine Gorman and Shenk to provide a solution with less utility than the Gorman implementation alone, without Shenk. Therefore, for at least these reasons, Applicants respectfully request that the rejection to claim 46 be withdrawn.

In addition, claims 47, 64, and 65 depend from claim 46 and include all of the features of claim 46, plus additional features. Therefore, for at least the reasons discussed above with respect to claim 46, Applicants respectfully request that the rejection of claim 47 be withdrawn and that claims 64 and 65 be allowed.

The Office Action rejected claims 48 and 55 for the same reasons it rejected claim 46. Therefore, for at least the reasons discussed above with respect to claim 46, Applicants respectfully request that the rejection of claims 48 and 55 be withdrawn.

The Office Action rejected claims 49, 52, 56, and 61 for the same reasons it rejected claim 47. Therefore, for at least the reasons discussed above with respect to claim 47, Applicants respectfully request that the rejection of claims 49, 52, 56, and 61 be withdrawn.

The Office Action rejected claim 57 for the same reasons it rejected claim 48. Therefore, for at least the reasons discussed above with respect to claim 48, Applicants respectfully request that the rejection of claim 57 be withdrawn.

The Office Action rejected claims 53, 58, and 62 for the same reasons it rejected claim 49. Therefore, for at least the reasons discussed above with respect to claim 49, Applicants respectfully request that the rejection of claims 53, 58, and 62 be withdrawn.

Claims 50, 51, 54, 59, 60, and 63 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,901,346 to Erving ("Erving") in view of Gorman and further in view of Shenk. Applicants respectfully traverse the rejection.

Neither Erving nor Gorman nor Shenk, alone or in combination, disclose or suggest "in response to the handset being removed from the handset-receiving portion during the telephone call, muting the audio input and maintaining to communicate the audio output of the telephone call via the hands-free audio interface," which is recited in amended claim 46. The Office Action rejected claim 50 for the same reasons it rejected previous claim 46, with the addition of the Erving reference to provide the computer-readable storage medium recited in claim 50. Erving is not cited for support in relation to the rejection of previous claim 46 and does not disclose or suggest "in response to the handset being removed from the handset-receiving portion during the telephone call, muting the audio input and maintaining to communicate the audio output of the telephone call via the hands-free audio interface." Therefore, for at least the reasons discussed above with respect to claim 46, Applicants respectfully request that the rejection of claim 50 be withdrawn.

In addition, claim 51 depends from claim 50 and includes all of the features of claim 50, plus additional features. Therefore, for at least the reasons discussed above with respect to claim 50, Applicants respectfully request that the rejection of claim 51 be withdrawn.

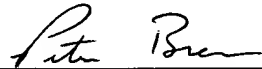
The Office Action rejected claim 59 for the same reasons it rejected claim 50. Therefore, for at least the reasons discussed above with respect to claim 50, Applicants respectfully request that the rejection of claim 59 be withdrawn.

The Office Action rejected claims 54, 60, and 63 for the same reasons it rejected claim 51. Therefore, for at least the reasons discussed above with respect to claim 51, Applicants respectfully request that the rejection of claims 54, 60, and 63 be withdrawn.

Additionally, Applicants have not received the completed form PTO-1449 associated with their First Supplemental Information Disclosure Statement of January 10, 2000. Applicants respectfully request the Examiner provide a copy of the completed form.

For all of the above reasons, Applicants respectfully request reconsideration and allowance of the present application. The Examiner is invited to contact the undersigned attorney at (312) 222-8101 if there are any outstanding issues that could be resolved through a telephone conference.

Respectfully submitted,



Peter C. Breen
Registration No. 47,441
Attorney for Applicants

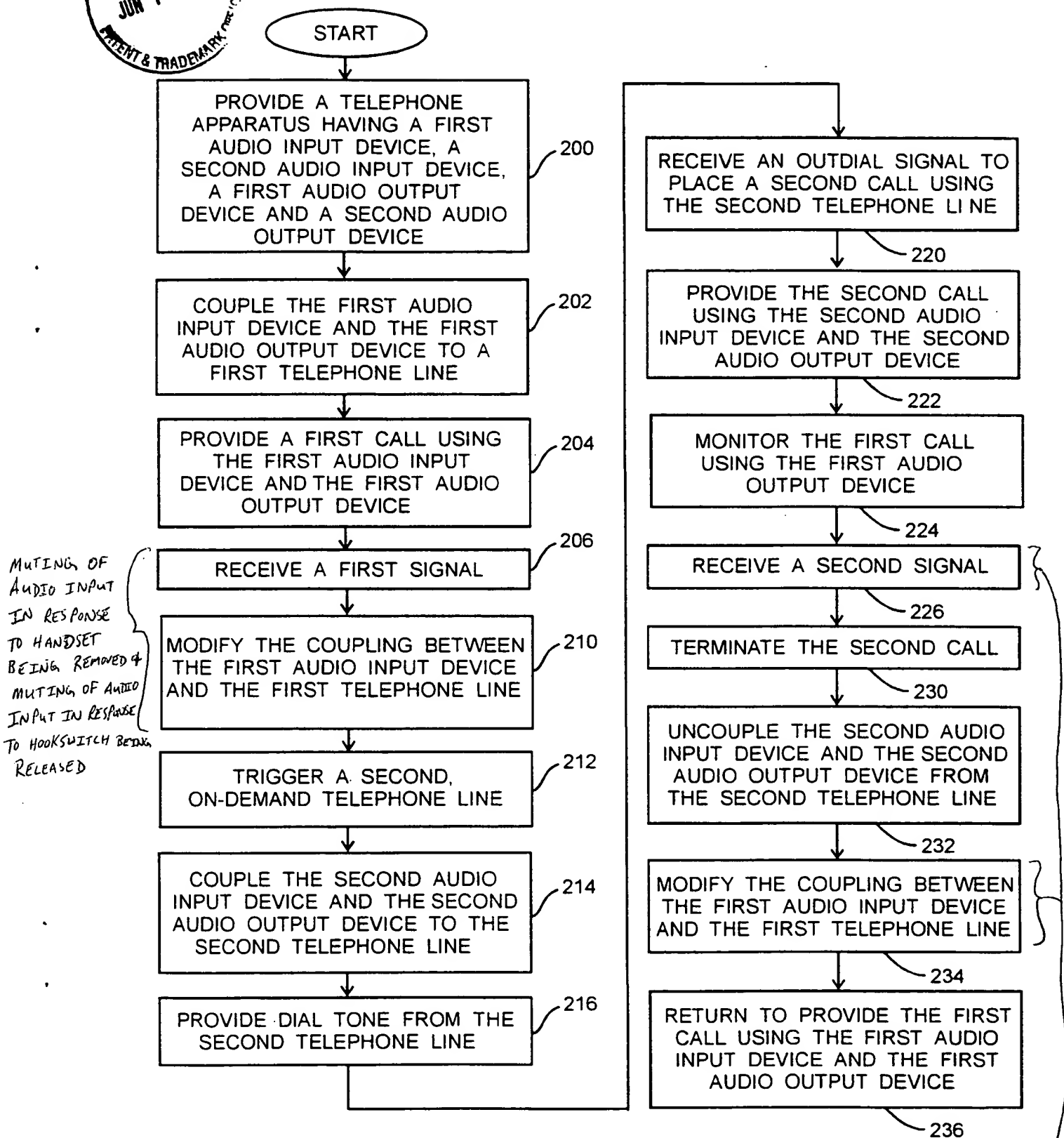


Fig. 3